

REMARKS

Applicants respectfully acknowledge receipt of the Office Action mailed on July 18, 2007.

In the Office Action, the Examiner (1) rejected claims 14-16 under 35 U.S.C. §102(e) as being anticipated by *Ueda* (U.S. Patent No. 6,122,009); (2) rejected claims 17 and 21-27 under 35 U.S.C. §103(a) as being unpatentable over *Ueda*, (3) rejected claims 18-20, 28, and 30-37 under 35 U.S.C. §103(a) as being unpatentable over *Ueda* in view of *Toyoda et al.* (U.S. Pub. No. 2001/0012073); and (4) rejected claims 29 and 38 under 35 U.S.C. §103(a) as being unpatentable over *Ueda* and *Toyoda*, and further in view of *Basista et al.* (U.S. Patent No. 4,451,124).

By this Amendment, Applicants amend claims 14, 28, 37, and add new claim 39. Upon entry of this Amendment, claims 14-39 will remain pending. Of these claims, claims 14, 28, and 37 are independent. The originally filed specification, claims, abstract, and drawings fully support the amendments to claims 14, 28, 37, and new claim 39. No new matter has been introduced.

Applicants traverse the rejections above and respectfully request reconsideration for at least the reasons that follow.

A. 35 U.S.C. §102(e) REJECTION

Claims 14-16 stand rejected under 35 U.S.C. §102(e) as being unpatentable over *Ueda*. Applicants respectfully disagree with the Examiner's arguments and conclusions and submit that independent claim 14 is patentably distinguishable over *Ueda* at least for the following reasons set forth below.

In order to properly establish that *Ueda* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be disclosed, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

In particular, *Ueda* fails to disclose the claimed combinations, including an image pickup device having, among other things, an image pickup element having a photoelectrically converting section surrounded by a peripheral top surface, an optical member having a lens section and a leg section with a contact surface provided at a lower end of the leg section, and a lens frame mounted to a base board and having a slidable contact surface at a lower end thereof, wherein a position between the lens section and the photoelectrically converting section is determined by bringing the slidable contact surface of the optical member into direct contact with the peripheral top surface or with a top surface member when the top surface member is provided on the peripheral surface of the image pickup element and by bringing the slidable contact surface of the lens frame in direct contact with only a top surface of the base board, as required by each of amended claims 14, 28, and 37.

Ueda discloses an image pickup apparatus having, among other things, a substrate 51, a holder 52 a photoelectric converting device such as a CCD bare chip 12, an image forming lens 54, black resin 66, and a leg portions 62. (*Ueda*, Figs. 45-46). The Examiner contends that Fig. 45 of *Ueda* shows that when optical element 54

is mounted on the photoelectric section 12, “the position between the lens section 54 and the photoelectrically converting section is determined by bringing the contact surface in direct contact with the peripheral top surface or with a top surface member.” (July 18, 2007, Office Action, p. 5.) Applicants respectfully disagree.

Ueda fails to show that optical member 54 is brought into direct contact with a top surface member of image pickup element 12. *Ueda* discloses that the optical member (image forming lens 54) is actually disposed on substrate 51. (*Ueda*, Figs. 45-46; col. 23, ll. 26-31) Although image pickup element 12 is located on base board 51, the top surface of pickup element 12 is not brought into direct contact with the optical member 54 as illustrated in Fig. 45 of *Ueda*. Moreover, Figure 46 of *Ueda* shows that connection wire 12A is actually in direct contact with image pickup element 12.

Further, the Examiner contends that when lens frame 66 is positioned on the base board 51, the position between the lens section and the photoelectrically converting section 12 in a direction perpendicular to the optical axis is determined by bringing the contact surface of the lens frame in direct contact with only a top surface of the base board and by positioning the lens frame on the base board. Applicants respectfully disagree.

Contrary to the Examiner’s contention that element 66 of *Ueda* is a lens frame, it is actually disclosed as a black resin that is used for molding the holder 52. Even assuming that resin 66 can be used as a lens frame, which Applicants do not concede, *Ueda* discloses that image forming lens 54 is disposed on a base board substrate 51, with the outer periphery of substrate 51 and optical member 54 being molded with a

black resin 66. (*Ueda*, Figs. 45-46; col. 23, ll. 26-31). Thus, the positioning is not determined by bringing the slidable contact surface of the lens frame in direct contact with only a top surface of the base board because the use of black resin 66 precludes the step of moving the lens frame into position, as stated in amended claim 14.

Accordingly, the use of black resin 66 doesn't allow for the position between the lens section and the photoelectrically converting section of the image pickup element in an optical axis direction to be determined by bringing the contact surface of the optical member in direct contact with the peripheral top surface.

Additionally, the Examiner contends that Applicants limitation of "positioning the lens frame on the base board" is broad and is being read as just positioning the lens frame on the base board and not moving the lens frame in order to position the lens frame on the base board. Applicants respectfully disagree.

As evidenced by amended claim 14, the step of moving the lens frame is achieved with a lens frame that has a slidable contact surface at a lower end thereof and the position between the lens section and the photoelectrically converting section of the image pickup element in a direction perpendicular to the optical axis is determined by bringing the slidable contact surface of the lens frame in direct contact with only a top surface of the base board and by positioning the contact surface of the lens frame on the base board.

Further, *Ueda* fails to show positioning is determined by bringing the slidable contact surface of the lens frame in direct contact with only a top surface of the base board and by positioning the slidable contact of the lens frame on the base board.

Ueda, also fails to teach or suggest wherein the lens frame 66 has a slidable contact surface at a lower end thereof which allows it to be positioned and moved onto the base board (emphasis added).

As illustrated in Fig. 45 of *Ueda*, the lens frame 66 does not have a slidable contact surface that can be brought in direct contact with a top surface of the base board 51 due to the molding of the holder 52 in resin 66. The use of black resin 66 inherently prevents it from being used as lens frame having a slidable contact surface that can be moved to be brought in direct contact with a top surface of the base board 51.

The Examiner has therefore not met the essential criteria for showing anticipation, wherein “each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in...a...single reference.” See M.P.E.P. § 2131. Accordingly, independent claim 14 under 35 U.S.C. § 102(e) should be allowed.

Moreover, claims 15-17 and 21-27 are in condition for allowance at least due to their dependence from independent claim 14. In addition, at least some of the dependent claims may recite unique combinations that are neither disclosed nor suggested by the cited art, and therefore some also are separately patentable.

A. 35 U.S.C. §103(a) REJECTION

Claims 17 and 21-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ueda*. Applicants respectfully traverse the Examiner's rejection of

claims 17 and 21-27 and hold that the cited prior art fails to disclose or suggest each element of the invention recited in amended independent claim 14.

Ueda fails to disclose, teach, or otherwise suggest the claimed combination, including an image pickup device having, among other things, an image pickup element having a photoelectrically converting section surrounded by a peripheral top surface, an optical member having a lens section and a leg section with a contact surface provided at a lower end of the leg section, and a lens frame mounted to a base board and having a slidable contact surface at a lower end thereof, wherein a position between the lens section and the photoelectrically converting section is determined by bringing the slidable contact surface of the optical member into “direct contact with the peripheral top surface or with a top surface member” of the image pickup element and by “bringing the slidable contact surface of the lens frame in direct contact with only a top surface of the base board,” as required by amended claim 14. (emphasis added). For at least these reasons, Applicants submit that claims 17 and 21-27 are allowable at least due to their dependence from independent claim 14, which has been described above.

Claims 18-20, 28, and 30-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ueda* in view of *Toyoda et al.* Applicants respectfully traverse the Examiner’s rejection of claims 18-20, 28, and 30-37 and submit that independent claims 28 and 37 are patentably distinguishable over *Ueda* and *Toyoda* at least for the following reasons.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone

or combined, must teach or suggest each and every element recited in the claims.

Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Each of the three requirements, moreover, must "be found in the prior art, and not be based on applicant's disclosure."

See M.P.E.P. §2143, 8th ed., February 2003.

As admitted by the Examiner, *Ueda* fails to teach "an elastic member to press the optical member toward the image pickup element with an elastic force in an optical axis direction." Accordingly, in order to cure the deficiencies of *Ueda*, the Examiner relies on *Toyoda et al.* for its alleged disclosure of "an elastic member 110 (figure 8) for absorbing the play of the holder (Paragraph 0003)." (July 18, 2007, *Office Action*, p. 9, paragraph 11). Applicants note, however, that *Toyoda et al.* does not teach or suggest, among other things, a lens frame that has a slidable contact surface at a lower end thereof and the position between the lens section and the photoelectrically converting section of the image pickup element in a direction perpendicular to the optical axis is determined by bringing the slidable contact surface of the lens frame in direct contact with only a top surface of the base board and by positioning the slidable contact of the lens frame on the base board, as recited in proposed amended claims 14, 28, and 37. (emphasis added). Thus the teachings of *Toyoda et al.* still fails to overcome the above noted deficiencies of *Ueda*.

Therefore *Toyoda et al.* taken alone or in combination, fails to cure the above described deficiencies of *Ueda*, and the Examiner's proposed combination of *Ueda* and *Toyoda et al.* does not teach, disclose, or otherwise suggest each and every limitation of independent claims 14, 28, and 37. The Examiner has not met at least one of the essential criteria for establishing a *prima facie* case of obviousness, wherein "the prior art reference (or references when combined) must teach or suggest all the claim limitations." See M.P.E.P. §§ 2142, 2143, and 2143.03. Accordingly independent claims 14, 28, and 37 and their corresponding dependent claims are patentable over *Ueda* and *Toyoda et al.*

Claims 29 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ueda* in view of *Toyoda et al.* and further in view of *Basista et al.* Applicants respectfully traverse the Examiner's rejection of claims 29 and 38. Even if *Basista et al.* teaches what the Examiner alleges (and Applicants do not necessarily agree that it does), *Basista et al.* fails to overcome the above-described shortcomings of *Ueda* and *Toyoda et al.* Accordingly, claims 29 and 38 are patentable at least due to their dependencies from claims 28 and 37, respectively. Applicants therefore request that the rejection of claims 29 and 38 under 35 U.S.C. § 103(a) be withdrawn.

III. CONCLUSION

Applicants respectfully submit that independent claims 14, 28, and 37 are in condition for allowance. In addition, claims 15-27, 29-36, 38, and 39 are in condition for allowance at least due to their corresponding dependence from claims 14, 28, and 37.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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